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09/373,589	08/13/1999	NAOSHI SUGIYAMA	Q55419	2742

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SUGHRUE MION ZINN MACPEAK & SEAS  
2100 PENNSYLVANIA AVENUE N W  
WASHINGTON, DC 20037

EXAMINER

MITCHELL, MONICA J

ART UNIT PAPER NUMBER

2622

DATE MAILED: 07/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/373,589

Applicant(s)

SUGIYAMA ET AL.

Examiner

Monica J. Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,9-14,17-19,21-30 and 34-36 is/are rejected.
- 7) ☒ Claim(s) 3,5-8,15,16,20,31-33,37 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is in response to: amended response received April 11, 2003.
2. Claims 1-37 pending.

### ***Response to Arguments***

3. The indicated allowability of claims 1-20 and 30 is withdrawn in view of the newly discovered reference(s) to Merz et al (U.S. Patent Number 6,246,776) and Biegelsen et al. (U.S. Patent Number 6,335,084). Rejections based on the newly cited reference(s) follow.

4. Applicant's arguments with respect to claims 21-29 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 4, 17 and 30 rejected under 35 U.S.C. 102(e) as being anticipated by Merz et al (U.S. Patent Number 6,246,776).

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Regarding claim 1, Merz discloses a printer for recording an image on recording material, comprising: a first input unit (Figure 1 and 2, reference element 20) for inputting discernment information of said recording material being loaded (column 3, lines 26-35); and a discriminator (Figures 1 and 2; reference element 16) for storing reference information representing acceptable recording material (column 3, lines 49-65), and for checking said discernment information with reference to said reference information to judge whether said recording material is acceptable or unacceptable, printing operation is inhibited and/or an alarm signal is generated (column 3, line 66 to column 4, line 12).

Regarding claim 2, Merz discloses a printer further comprising: a pick-up unit for picking up an object to create image data (Figure 1 and 2, reference element 13 inherently teaches that in order for the image processing unit to process an image, it has to be picked up from a source whether it is a PC, a scanner, a fax, etc.); a printing head for printing an object image to said recording material according to said image data column 2, line 62 to column 3, line 8).

Regarding claim 4, Merz discloses a printer wherein said discernment information is provided on said recording material in an externally readable manner, said first input unit comprises an information reader for reading said discernment information (column 5, lines 5-12).

Regarding claim 17, Merz discloses a printer wherein said discriminator is operated upon powering on.

Regarding claim 30, Merz discloses a printing method of recording an image on recording material, comprising the steps of: reading predetermined discernment information from said recording material (column 3, lines 26-35), said predetermined discernment information being provided for said recording material (column 3, lines 26-35); predetermining reference information (column 3, lines 49-65); and checking said predetermined discernment information with reference to said reference information to judge whether said recording material is acceptable or unacceptable, wherein if said recording material is unacceptable, printing operation is inhibited and/or an alarm signal is generated (column 3, line 66 to column 4, line 12).

7. Claims 21, 24, 25, 26 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Biegelsen et al. (U.S. Patent Number 6,335,084).

Regarding claim 21, Biegelsen discloses a recording material comprising: a printing surface and a back surface (column 3, lines 47-49); discernment information prerecorded on said printing surface or said back surface readably (column 3, lines 51-64); and wherein said recording material is judged as acceptable when said discernment information is in accordance with a reference information (column 5, lines 9-29).

Regarding claim 24, Biegelsen discloses a recording material wherein said printing surface has an effective printing region and a peripheral region defined thereabout, and said discernment information is disposed in said peripheral region (column 4, lines 20-32).

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Regarding claim 25, Biegelsen discloses a recording material wherein said discernment information is constituted by a positioning indicia disposed in a predetermined position and adapted to recording material positioning for printing (column 4, lines 20-39).

Regarding claim 26, Biegelsen discloses a recording material wherein discernment information is constituted by at least one of a length, a width, a shape and a pitch of said positioning indicia (column 4, lines 10-19).

Regarding claim 28, Biegelsen discloses a recording material comprising: a printing surface and a back surface (column 3, lines 47-49); a positioning indicia prerecorded on said printing surface or said back surface (column 3, lines 51-64), and adapted to recording material positioning for printing (column 4, lines 20-39), wherein at least one of a length, a width, a shape and a pitch of said positioning indicia constitutes predetermined discernment information (column 4, lines 10-19).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 9, 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merz et al (U.S. Patent Number 6,246,776) and further in view of Huston (U.S. Patent Number 5,816,165).

Regarding claim 9, Merz fails to disclose a printer wherein said discernment information comprises a code for representing at least a recording material dealer of said recording material.

However, Huston discloses a printer wherein said discernment information comprises a code for representing at least a recording material dealer of said recording material (column 3, lines 28-31).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the inventions were made to include the teachings of Huston with the teachings of Merz to provide information indicative to the manufacturing of a printing media which rotates at the same speed as the printing drum.

Regarding claim 10, Merz fails to disclose a printer wherein said discernment information comprises a code of which at least one portion represents a recording material distribution channel of said recording material.

However, Huston discloses a printer wherein said discernment information comprises a code of which at least one portion represents a recording material distribution channel of said recording material (column 3, lines 28-31).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the inventions were made to include the teachings of Huston with the teachings of Merz to provide information indicative to the manufacturing of a printing media which rotates at the same speed as the printing drum.

Regarding claim 14, Merz fails to disclose a printer wherein said recording material includes: a positioning indicia prerecorded thereon and adapted to recording

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material positioning for printing and an auxiliary indicia prerecorded at a predetermined distance from said positioning indicia in a feeding direction of said recording material, said predetermined distance constituting said discernment information.

However, Regarding claim 14, Huston discloses a printer wherein said recording material includes: a positioning indicia (read as "mark A") prerecorded thereon and adapted to recording material positioning for printing (column 3, lines 41-54); and an auxiliary indicia (read as "mark B") prerecorded at a predetermined distance from said positioning indicia in a feeding direction of said recording material (column 2, line 65 to column 3, line 23), said predetermined distance constituting said discernment information (column 3, lines 41-54).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the inventions were made to include the teachings of Huston with the teachings of Merz to provide information indicative to the length of paper remaining on the roll.

10. Claims 11, 12, 13, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merz (U.S. Patent Number 6,246,776) and further in view of Biegelsen (U.S. Patent Number 6,335,084).

Regarding claim 11, Merz fails to disclose a printer wherein discernment information is a binary code including plural bits.

However, Biegelsen discloses a printer wherein discernment information is a binary code including plural bits (column 4, lines 1-10).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the inventions were made to include the teachings of Biegelsen with the



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teachings of Merz to process a sheet of material based upon the indicia/code that is arranged on the material.

Regarding claim 12, Merz fails to disclose a printer wherein said discernment information is constituted by a positioning indicia disposed on said recording material in a predetermined position, and adapted to recording material positioning for printing.

However, Biegelsen discloses a printer wherein said discernment information is constituted by a positioning indicia disposed on said recording material in a \_\_\_\_\_ predetermined position, and adapted to recording material positioning for printing (column 4, lines 20-39).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the inventions were made to include the teachings of Biegelsen with the teachings of Merz to process a sheet of material based upon the indicia/code that is arranged on the material.

Regarding claim 13, Merz fails to disclose a printer wherein said discernment information is represented by at least one of a length, a width, a shape and a pitch of said positioning indicia.

However, Biegelsen discloses a printer wherein said discernment information is represented by at least one of a length, a width, a shape and a pitch of said positioning indicia (column 4, lines 10-19).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the inventions were made to include the teachings of Biegelsen with the

teachings of Merz to process a sheet of material based upon the indicia/code that is arranged on the material.

Regarding claim 18, Merz fails to disclose a printer further comprising a recording material sensor for detecting said recording material being loaded; and wherein said discriminator is operated in response to detection of new loading of said recording material at said recording material sensor.

However, Biegelsen discloses a printer further comprising a recording material sensor (Figure 8, reference element 24) for detecting said recording material being loaded (column 5, lines 9-12); and wherein said discriminator is operated in response to detection of new loading of said recording material at said recording material sensor(column 5, lines 13-29).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the inventions were made to include the teachings of Biegelsen with the teachings of Merz to process a sheet of material based upon the indicia/code that is arranged on the material.

Regarding claim 19, Merz fails to disclose a printer wherein said recording material comprises at least first and second types of recording material; said printer comprising at least first and second printer units for recording to respectively said at least first and second types of said recording material.

However, Biegelsen discloses a printer wherein said recording material comprises at least first and second types of recording material (column 5, line 60 to column 6, line 6); said printer comprising at least first and second printer units for

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recording to respectively said at least first and second types of said recording material (column 6, lines 7-28).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the inventions were made to include the teachings of Biegelsen with the teachings of Merz to process a sheet of material based upon the indicia/code that is arranged on the material.

11. Claims 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biegelsen et al (U.S. Patent Number 6,335,084) and further in view of Huston (U.S. Patent Number 5,816,165).

Regarding claim 22, Biegelsen fails to disclose a recording material wherein said discernment information is a code and includes information of a recording material dealer and/or a recording material distribution channel.

However, Huston discloses a recording material wherein said discernment information is a code and includes information of a recording material dealer and/or a recording material distribution channel (column 3, lines 28-31).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the inventions were made to include the teachings of Huston with the teachings of Biegelsen to provide information indicative to the manufacturing of a printing media which rotates at the same speed as the printing drum.

Regarding claim 23, Biegelsen fails to disclose a recording material wherein said discernment information further includes information of a recording material type, a recording material printing format and a recording material size.

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However, Huston discloses a recording material wherein said discernment information further includes information of a recording material type, a recording material printing format and a recording material size (column 3, lines 28-31).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the inventions were made to include the teachings of Huston with the teachings of Biegelsen to provide information indicative to the manufacturing of a printing media which rotates at the same speed as the printing drum.

Regarding claim 27, Biegelsen fails to disclose a recording material further comprising: a positioning indicia prerecorded thereon and adapted to recording material positioning for printing; and an auxiliary indicia prerecorded at a predetermined distance from said positioning indicia in a feeding direction of said recording material, said predetermined distance constituting said discernment information.

However, Huston discloses a recording material further comprising: a positioning indicia (read as "mark A") prerecorded thereon and adapted to recording material positioning for printing (column 3, lines 41-54); and an auxiliary indicia (read as "mark B") prerecorded at a predetermined distance from said positioning indicia in a feeding direction of said recording material (column 2, line 65 to column 3, line 23), said predetermined distance constituting said discernment information (column 3, lines 41-54).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the inventions were made to include the teachings of Huston with the teachings

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of Biegelsen to provide information indicative to the length of paper remaining on the roll.

Regarding claim 29, Biegelsen discloses a recording material comprising: a printing surface and a back surface (column 3, lines 47-49); and wherein said recording material is judged as acceptable when said discernment information is in accordance with a reference information (column 5, lines 9-29).

Biegelsen fails to disclose a recording material further comprising: a positioning indicia prerecorded on said printing surface or said back surface and adapted to recording material positioning for printing; and an auxiliary indicia prerecorded on said printing surface or said back surface at a predetermined distance from said positioning indicia in a recording material feeding direction, said predetermined distance constituting said predetermined discernment information.

However, Huston discloses a recording material further comprising: a positioning indicia (read as "mark A") prerecorded on said printing surface or said back surface and adapted to recording material positioning for printing (column 3, lines 41-54); and an auxiliary indicia (read as "mark B") prerecorded on said printing surface or said back surface at a predetermined distance from said positioning indicia in a feeding direction of said recording material (column 2, line 65 to column 3, line 23), said predetermined distance constituting said predetermined discernment information (column 3, lines 41-54).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the inventions were made to include the teachings of Huston with the teachings

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of Biegelsen to provide information indicative to the length of paper remaining on the roll.

Regarding claims 34-36, Biegelsen fails to disclose a recording material wherein said recording material is continuous.

However, Huston discloses a recording material wherein said recording material is continuous (column 2, lines 55-61).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the inventions were made to include the teachings of Huston with the teachings of Biegelsen to provide continuous length of print media to be marked with length media.

### ***Allowable Subject Matter***

12. Claims 3, 5-8, 15, 16, 20, 31-33 and 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica J. Mitchell whose telephone number is 703-306-3430. The examiner can normally be reached on Mon.-Fri., 7:30 a.m. to 4:30 p.m.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703-305-4712. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703-872-9313 for regular communications and 703-872-9313 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

mjm  
June 25, 2003

  
EDWARD COLES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600